

REMARKS

In the Advisory Action of November 22, 2005, the Examiner has entered the Amendment After Final, filed June 28, 2005. However, the Examiner has provided only a single ground for rejection. The entire Advisory Action reads:

All the references cited by the Applicant in the AF support the Examiner's position that the use of *Agrobacterium tumefaciens* transformation of flax hypocotyls were both required for high efficiency transformation and normal morphology. Bombardment is not taught in the instant specification, which must be enabling (prior art is not enabling).

Applicants infer that all other rejections are overcome. If this inference is incorrect, then Applicants invite the Examiner to review the June 28, 2005 Response After Final and address the arguments presented there.

The rejection with respect to transformation of flax hypocotyls with *Agrobacterium* was previously made as a rejection for alleged lack of enablement. The Examiner has previously argued that the transformation of *Agrobacterium* is an "essential step" in the disclosed methods and must therefore be included in the claims.

Applicants traversed this rejection, citing two references that describe *Agrobacterium tumefaciens* transformation of flax [Bretagne-Sagnard et al. (1996); McHughen and Jordan (1989)], one reference that describes *Agrobacterium rhizogenes* transformation of flax [Zhan et al. (1988)], and one reference that describes protoplast transformation of flax [Ling (1997)], and one reference that describes particle bombardment transformation of flax (U.S. Patent No. 5,973,227, issued October 26, 1999). These references demonstrate that skilled artisans were, at the filing date, able to employ various approaches to achieving flax transformation. Therefore, the specification is enabling for more than just transformation with *Agrobacterium tumefaciens*.

The Examiner has now suggested that the cited references tend to show that only *Agrobacterium tumefaciens* transformation is workable to achieve high efficiency flax transformation and morphologically normal transformants.

Applicants disagree with the basis for rejection. The claims can be practiced to their full scope without undue experimentation, regardless of whether the results that are achieved meet an arbitrary threshold of efficiency and morphological characteristics. The Examiner appears to have improperly imported such a threshold limitation into the claims. The claimed methods may

be used with any available method of flax transformation. It is expected that the practice of the claimed invention will provide improvements in the selected transformation process, but such improvement is not required in each and every transformation technique in order for the claim to be enabled. It is reasonable to expect that most or all methods of flax transformation will benefit from the claimed inventions because the specification provides numerous working examples with different genetic backgrounds. Nonetheless, the claimed inventions are novel, non-obvious and enabled regardless of the degree to which the practice of the claims yields improvements in any particular flax transformation technique.

The Examiner has further argued that the technique of transformation by particle bombardment is not adequately enabled by the specification. The Examiner argues that prior art cannot be used to support enablement.

Applicants disagree. Because enablement is determined from the perspective of one of ordinary skill in the art, knowledge in the art is available to support the enablement of the specification. The Federal Circuit has written, "The test of enablement is whether one reasonably skilled in the art could make or use the invention from disclosures in the patent *coupled with information known in the art* without undue experimentation." (*emphasis added*). *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). The present application does discuss the technique of particle bombardment, and cites numerous articles that describe this approach for the transformation in plants generally. See page 6, lines 16-20.

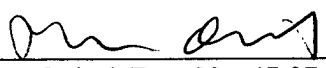
Applicants believe that all outstanding rejections have now been addressed. Applicants request reconsideration and withdrawal of the rejections of claims 1 and 4-23 for alleged lack of enablement.

CONCLUSION

For the reasons presented above, Applicants request that the Examiner allow the claims, as amended, to issue. The Examiner may address any questions raised by this submission to the undersigned at 212-596-9000. Applicants hereby request that any fee required, in addition to the fee supplied with the Request for Extension of Time, be charged to Deposit Account No. 06-1075.

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Respectfully submitted,

By 
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